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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,740	11/11/2003	Richard B. Greenwald	213.1207	4315

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LUCAS & MERCANTI, LLP  
475 PARK AVENUE SOUTH  
15TH FLOOR  
NEW YORK, NY 10016

EXAMINER
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HEARD, THOMAS SWEENEY

ART UNIT	PAPER NUMBER
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1654

MAIL DATE	DELIVERY MODE
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01/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/705,740	<b>Applicant(s)</b> GREENWALD ET AL.	
	<b>Examiner</b> Thomas S. Heard	<b>Art Unit</b> 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-14, 16-33 is/are pending in the application.
- 4a) Of the above claim(s) 27-32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24--25 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14, 19-23, 26 and 33 is/are rejected.
- 7) ☐ Claim(s) 16-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The Applicants Amendments to the claims received on 12/05/2007 is acknowledged. The text of those sections of Title 35 U.S. Code not included in the action can be found in the prior office action. Rejections or objections not addressed in this office action with respect to the previous office action mailed 9/5/2007 are hereby withdrawn.

Claim(s) 1-6, 8-14, and 16-33 are pending. Applicants have amended claim(s) 2, 3, 4, 5, 8, 9, 12-14, 19, 22, 23, 24, and 25. Claims 27-32 are withdrawn. Claims 1-6, 8-14, and 16-33 are hereby examined on the merits.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-14, 19, 20-23 and 26 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "multi-armed polyalkylene oxide." There is insufficient antecedent basis for this limitation in the claim because a linear polyethylene glycol is claimed in Claim 1. Because Claim 10-20 depend from indefinite claim 9 and do not clarify the point of confusion, they must also be rejected under 35 U.S.C. 112, second paragraph.

Claim 21 recites structures that a made from branched polyethylene glycol moieties. There is insufficient antecedent basis for this limitation in the claim because a linear polyethylene glycol is claimed in Claim 1 and Claim 21 is drawn to branched structure not envisioned in Claim 1. Because Claim 22 and 23 depend from indefinite claim 21 and do not clarify the point of confusion, they must also be rejected under 35 U.S.C. 112, second paragraph.

Claim 26 recites structures that a made from branched polyethylene glycol moieties. There is insufficient antecedent basis for this limitation in the claim because a linear polyethylene glycol is claimed in Claim 1 and Claim 26 is drawn to branched structure not envisioned in Claim 1.

Applicant's arguments have been carefully considered but are not found to be persuasive to overcome the rejection. Applicants have argued:

Concerning the Examiner's comments on claim 9 and dependent claims 10-20, file Examiner has taken the position that a "linear" polyethylene glycol is claimed in claim 1. Applicants respectfully disagree. The R1 group of claim 1 includes "branched" and "multi-armed" polyalkylene oxides as well as the "linear" polyalkylene oxide as proposed by the Examiner. See page 12, paragraph [0025], lines 17-20. Accordingly, some preferred embodiments of the "branched" and "multi-armed" polymers are described on pages 16-17, paragraph [0030]; and pages 19-21, paragraph [0033] of the specification. Applicants wish to draw the Examiner's attention that "R" having the linear polyethylene glycol is part of each of the polymer arms in the branched and multi-armed polymers, instead of "R1" referring to the general polymers of claim 1 including linear, branched and multi-armed polymers.

Further, the Applicants have argued in response to the rejections on Claims 21 and 26, stating:

Concerning the Examiner's comments on claim 21 and dependent claims 22-23, and claim 26, Applicants respectfully disagree. Similarly, the reasons set forth above are incorporated herein.

The term multi-armed is not defined and lacks antecedent basis despite the preferences referred to in the specification. Further, since the arguments put forth for Claim 19 are not found to be persuasive, neither are these arguments persuasive for Claims 21 and 26. Therefore, the rejection stands as stated supra.

### **New Grounds of rejection**

#### ***Claim Objections***

Claims 16-18 are objected to because of the following informalities: dependency to canceled claim. Appropriate correction is required.

#### ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 11 and 33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, the term "residue" is not clear as to what is being intended. For example, is the formula itself the residue or can an altered chemical structure be a residue.

In Claim 3 and 11, capping group is not defined and is vague and indefinite. It is suggested that the Applicants consider what J is and incorporate those moieties into the claim(s).

***The following is a quotation of the first paragraph of 35 U.S.C. 112:***

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant invention is drawn to multi-armed polyalkylene oxide. There is lack of written description for this concept and term as Applicants have incorporated essential material by way of journal reference. 37 CFR 1.57(c) states that "Essential material" may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. "Essential material" is material that is necessary to:

- (1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112;
- (2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by the second paragraph of 35

U.S.C. 112; or

(3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by the sixth paragraph of 35 U.S.C. 112.

Therefore, Claims 9-20 lack written description.

### Conclusion

Claims 24 and 25 appear free of the prior art. No other claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP § 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 U.S.C. § 102 or 35 U.S.C. § 103(a) once the aforementioned issue(s) is/are addressed.

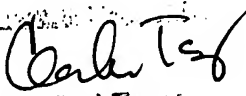
Applicant is requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Thomas S. Heard** whose telephone number is **(571) 272-2064**. The examiner can normally be reached on 9:00 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Thomas S. Heard  
Art Unit 1654

  
Cecilia Tsang  
Supervisor  
Patent Examination  
Art Unit 1654